



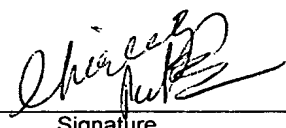
Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		<b>Docket Number (Optional)</b> 30550/38856A	
		<b>Application Number</b> 09/871,867-Conf. #2171	<b>Filed</b> June 1, 2001
		<b>First Named Inventor</b> Peter J. Malnekoff	
		<b>Art Unit</b> 3622	<b>Examiner</b> RETTA, Yehdega
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>50,555</u></p> <p> _____ Signature</p> <p>Chirag B. Patel _____ Typed or printed name</p> <p>(312) 474-6300 _____ Telephone number</p> <p>February 14, 2006 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

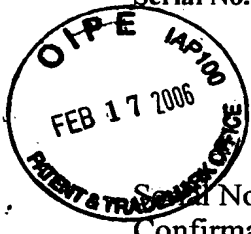
☐ \*Total of 1 forms are submitted.

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Dated: February 14, 2006

Signature: \_\_\_\_\_

(Chirag B. Patel)



**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Serial No. : 09/871,867 )

Confirmation : 2171 )

Applicants : Peter J. Malnekoff )

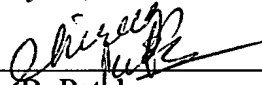
Filed : June 1, 2001 )

Title: AN AUTOMATED GEMSTONE  
EVALUATION SYSTEM )

Art Unit : 3622 )

Examiner : RETTA, Yehdega )

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February 14, 2006

  
Chirag B. Patel

Reg. No. 50,555

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
Mail Stop AF  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The applicant hereby requests a pre-appeal brief conference for a panel of examiners to formally review the legal and factual basis of the rejections in the application, prior to the filing of an appeal brief.

No amendments are being filed with this request. This request is being submitted concurrently with the Notice of Appeal.

It is submitted that the rejections are legally and factually inadequate, for the reasons concisely described on the following pages.

**I. BACKGROUND**

Claims 1-18, 20-22 are pending in the application. Claims 1-18 and 20-22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,239,867 to Aggarwal (hereinafter "Aggarwal"). Furthermore, claims 3, 10, 17, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aggarwal in view of U.S. Patent No. 5,828,405 to Vanier (hereinafter "Vanier"), whereas claim 20 is rejected under Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Aggarwal in view of "A Re-engineered Jewelry Appraisal System at Zale Corporation" MIS Quarterly/March 1994 (hereinafter "Zale").

The applicant respectfully traverses the examiner's rejection of claims 1-18 and 20-22 and respectfully requests reconsideration.

**II. CLAIMS 1-18 AND 20-22 ARE DESCRIBED IN THE SPECIFICATION:**

Claims 1-18 and 20-22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action alleges that the specification does not teach an input device receiving data via a remote communication device.

However, Col. 2, ll. 31-35 discloses that the "present invention provides for a remote access system, which allows gemstone data to be received from an input device located remotely, and the evaluation report to be communicated to a remotely located output device," wherein as disclosed in disclosed in Col. 4, ll. 24-29, the gemstone data "corresponds to the data contained on the various lab certificates typically associated with each gemstone." Thus, contrary to the Examiner's assertion, the specification clearly teaches the input device receiving the data via a remote communication device.

Furthermore, while the Office Action alleges that all the dependent claims are rejected since they depend on the rejected claim, claims 8 to 22 are not dependent on claim 1 and therefore, cannot be rejected under 35 U.S.C. § 112, first paragraph merely for being dependent upon claim 1.

### **III. CLAIM 1 AND ITS DEPENDENT CLAIMS ARE ALLOWABLE**

Claim 1 recites, among other things, a gemstone evaluation system having an input device adapted to receive gemstone data without the actual presence of the gemstone, a processing device adapted to compute a pricing estimate for use in an evaluation report and based at least on cut proportions of the gemstone, and an output device adapted to communicate the evaluation report to a system user.

#### **A. Aggarwal Fails To Disclose Creating An Evaluation Report In The Absence Of The Gemstone**

The Aggarwal provisional application does not disclose a gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone, in a manner recited by the claim 1. Specifically, while the first page of the Aggarwal provisional application discloses a method of determining a monetary value of a gemstone relative to the measured spectral response of the gemstone, unlike the automated gemstone evaluation system recited in claim 1, the method disclosed on the first page requires the presence of the gemstone to get its spectral response.

The gemstone evaluation system disclosed in Aggarwal uses a local imaging station to determine various characteristics of a gemstone to be evaluated. For example, such a local imaging station gauges a spectral response of the gemstone subject to plurality of light sources of the imaging station. The physical presence of the gemstone is absolutely necessary in using the system disclosed in Aggarwal.

On the other hand the system recited in claim 1 does not require physical presence of the gemstone at all. For example, using the system recited in claim 1, a user can prepare an evaluation report using a gemstone characteristic value communicated to the gemstone evaluation system over a communication network. Moreover, physical presence of the gemstone is not required even for such a remote communication of the gemstone data as information from a laboratory grading certificate or from a sales receipt of a gemstone may be used to determine such a gemstone characteristic value.

While the examiner has cited page 6 of the Aggarwal provisional application disclosing a database used to store various types of text, graphic, audio and video data and capable of generating a report, it is not clear as to what is the nature of the report, and whether the cited database has any type of information related to a gemstone. Aggarwal

certainly does not disclose creating an evaluation report without the presence of a gemstone as described in claim 1. Each of the paragraphs in cols. 1, 2 and 14-16 of the Aggarwal patent, which are cited by the Examiner in rejecting claim 1, note that the physical presence of a gemstone is necessary for its evaluation.

Furthermore, the Examiner argues that mere physical absence of a gemstone in the system recited in claim 1 is not patentably different from the system described in Aggarwal, which requires the presence of a gemstone for its evaluation before communicating the gemstone data remotely. The Applicant disagrees with the Examiner's argument because, while a user of the system recited in claim 1 can use a laboratory grading certificate provided by a client, a vendor, etc., to generate an appraisal without even having to have physically evaluated the gemstone, the system disclosed in Aggarwal will require the physical presence of a gemstone, in each and every case, at least at some point before an appraisal can be generated. Physical evaluation of gemstone, which is necessary for the system disclosed in Aggarwal, is a time consuming and expensive process requiring special equipment. Compared to that, the system recited in claim 1 allows a user to create an evaluation report in a convenient and substantially less expensive manner.

**B. Aggarwal Is Not Available As Prior Art**

The Aggarwal provisional application is not available as a prior art reference, as it does not contain support for the invention claimed in Aggarwal, as required by 35 U.S.C. §112, first paragraph. See, MPEP § 2136.03 IV, ("Filing Date Of U.S. Patent Application Can Only Be Used As The 35 U.S.C. § 102(E) Date If It Supports The Claims Of The Issued Child"). See also, *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981):

If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

In this case, the examiner has not, and cannot, demonstrate that the Aggarwal provisional application contains support for the invention claimed in the Aggarwal patent. For example, the Aggarwal provisional application contains no support for claims 25-26, 31, 34 or 35 of the Aggarwal patent.

For example, claim 34 of the Aggarwal patent recites “electronically transferring the information in the data file in connection with a transaction involving a gemstone.” However, a thorough review of the Aggarwal provisional application reveals that the Aggarwal provisional application does not even mention any “transaction involving a gemstone,” let alone disclosing any electronic transfer of information related to such a transaction. Similarly, claim 35 of the Aggarwal patent recites “[a] transition selected from the group consisting of marketing of a gemstone ...,” even though there is no mention of such a transaction related to the marketing of a gemstone in the Aggarwal provisional application.

Accordingly, the Aggarwal patent is not entitled to be used as prior art over the present application.

#### **C. Vanier Teaches Away Because It Requires the Presence of the Gemstone**

Furthermore, as suggested in the Applicant’s response dated June 13, 2005, Vanier teaches away from the invention recited in claims 3, 10 and 17. The Examiner’s argument that even though Vanier teaches away from the recited claims, it can be used to reject such claims under 35 U.S.C. § 103(a) is wrong because as Vanier teaches away from the recited claims, there is no motivation for one to combine Vanier with Aggarwal.

#### **IV. CONCLUSION**

It is respectfully submitted that this application is now in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application towards allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By: 

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February 14, 2006